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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|--------------|----------------------|---------------------|------------------|
| 09/816,235 | 03/26/2001 | Morihiko Sumino | P101201-00017 | 8723 |
| 7590 | 01/15/2004 | | EXAMINER | |
| AREN'T FOX KINTNER PLOTKIN & KAHN, PLLC Suite 600 1050 Connecticut Avenue, N.W. Washington, DC 20036-5339 | | | FERGUSON, KEITH | |
| ART UNIT | PAPER NUMBER | | | |
| | 2683 | | | |
| DATE MAILED: 01/15/2004 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|------------------------------|------------------------|---------------------|--|
| | 09/816,235 | SUMINO, MORIHIKO | |
| Examiner | Art Unit | | |
| Keith T. Ferguson | 2683 | | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 March 2001.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-5 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____ .
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Ishii.

The claimed invention reads on Ishii as follows:

Regarding claim 1, Ishii discloses a portable telephone apparatus (fig. 1) for roaming between a first portable telephone system (fig. 1 number A1) and a second portable telephone system (fig. 1 B1), comprising: reception means (mobile station responds to base station) for receiving a message transmitted from a base station in one of the two systems (col. 4 lines 50-55); judging means for judging whether a received message has a common format in the two systems (col. 4 lines 50-59 and col. 5 lines 40-54) or a different format (i.e. a message including a service option

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request order for deciding a communication mode) in the two systems (col. 5 lines 31-59); first processing means (the mobile telephone responds to the base station) (col. 4 lines 50-55) for processing the received message by performing a procedure common (i.e. the mobile station compares the first mobile radio system flag with existing mobile radio system flag to see if they coincide) (col. 4 line 55 through col. 5 line 6 and col. 5 lines 49-54) to the two systems (fig. 1 system A1 and system B1) when the message has the common format (same protocol software format) (col. 4 lines 60-67), and second processing means (the mobile telephone responds to the base station) (col. 5 lines 39-48) for processing the received message by performing procedures (col. 5 lines 44-54), each procedure unique to each of the two systems (i.e. second mobile radio system flag is compared with existing mobile radio system flag to see if they coincide) (col. 4 lines 55-59 and col. 5 lines 49-63), when the message has the different format (col. 5 lines 1-6 and col. 5 lines 55-63).

Regarding claim 2, Ishii discloses a protocol revision receiving means (i.e. the mobile telephone receives a revision protocol from area its located) for receiving from the base station (col. 7 line 64 through col. 8 line 26), a protocol revision message showing a type of communication protocol (Pcmda)

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used in one of the two systems (col. 7 line 64 through col. 8 line 26); wherein the reception means receives a succeeding message (pcdma) which succeeds the protocol revision message (Ptdma) (fig. 3 and col. 7 line 64 through col. 8 line 26), from the base station (fig. 3 and col. 7 line 64 through col. 8 line 26); the second processing means (downloading) processes the succeeding message (pcdma) by performing a procedure unique to the first system when the communication protocol in the first system is shown in the protocol revision message (col. 8 lines 6-50), and processes the following message by performing a procedure unique to the second system when the communication protocol in the second system is shown in the protocol revision message (col. 8 lines 6-50).

Regarding claim 3, Ishii discloses a base station (TDMA base station) (fig. 3 number 11) in the first system (fig. 3 number C1) transmits the protocol revision message (TDMA) on a first frequency (Ptdma) (col. 7 lines 5-12), and a base station (CDMA base station) (fig. 3 number 12) in the second system (fig. 3 number (D1) transmits the protocol revision message on a second frequency (Pcdma) (fig. 3) (col. 8 lines 6-15), wherein the protocol receiving means (mobile telephone receiver) receives either of the two protocol revision messages by scanning the

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first frequency (TDMA frequency) and the second frequency (CDMA frequency) (col. 7 lines 54-63).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii.

Ishii discloses a portable telephone apparatus as discussed supra in claim 1 above. Ishii differs from claim 4 of the present invention in that it does not disclose the first system is an IS-95 Code Division Multiple Access (CDMA) mobile telephone system, the second system is an ARIB STD-T53 CDMA mobile telephone system. However, IS-95 Code Division Multiple Access (CDMA) mobile telephone systems, and ARIB STD-T53 CDMA mobile telephone systems are well known in the art in cellular or wireless communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention

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was made for the first system to be an IS-95 Code Division Multiple Access (CDMA) mobile telephone system, the second system to be an ARIB STD-T53 CDMA mobile telephone system, since it was known in the art that IS-95 Code Division Multiple Access (CDMA) mobile telephone systems, and ARIB STD-T53 CDMA mobile telephone systems are used in cellular or wireless communication systems.

Regarding claim 5, Ishii discloses a protocol revision receiving means (i.e. the mobile telephone receives a revision protocol from area its located) for receiving from the base station (col. 7 line 64 through col. 8 line 26), a protocol revision message showing a type of communication protocol (Pcmda) used in one of the two systems (col. 7 line 64 through col. 8 line 26); wherein the reception means receives a succeeding message (pcdma) which succeeds the protocol revision message (Ptdma) (fig. 3 and col. 7 line 64 through col. 8 line 26), from the base station (fig. 3 and col. 7 line 64 through col. 8 line 26); the second processing means (downloading) processes the succeeding message (pcdma) by performing a procedure unique to the first system when the communication protocol in the first system is shown in the protocol revision message (col. 8 lines 6-50), and processes the following message by performing a procedure unique to the second system when the communication

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protocol in the second system is shown in the protocol revision message (col. 8 lines 6-50).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Van Den Heuvel et al. (U.S. Patent 6,223,030) discloses a communication operating system. Moles (US 2003/0017842 A1) discloses a wireless network system selection mechanism within a mobile station. Korpela (U.S. Patent 5,946,634) discloses mobile communications.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Keith Ferguson *WF*
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January 9, 2004